



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/587,806	07/27/2006	Elvir Causevic	10329.0013-00000	4995
22852	7590	10/20/2008		
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			EXAMINER NATNITHITHADHA, NAVIN	
			ART UNIT	PAPER NUMBER
			3735	
			MAIL DATE	DELIVERY MODE
			10/20/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/587,806

Applicant(s)

CAUSEVIC ET AL.

Examiner

NAVIN NATNITHITHADHA

Art Unit

3735

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 04 August 2008 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: _____.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.

/Charles A. Marmor, II/
Supervisory Patent Examiner, Art Unit 3735

Continuation of 11. does NOT place the application in condition for allowance because: In Applicant's Remarks, p. 10, filed 25 August 2008, Applicant provides new grounds of arguments based on evidence (Attachment to Remarks) that were not provided before the close of prosecution. Thus, Applicant must reopen prosecution before the Examiner can consider these new arguments and evidence.

Applicant contends, in the Remarks, p. 11, that "[n]either Zierhofer nor Najafi teaches or suggests [the particular claim 1] arrangement of a [sigma-delta] converter, where only the front-end of the converter is placed in the implantable device, and the generated 1-bit sequence is wirelessly transmitted to an external processing unit where the data is filtered for complete implementation of the sigma-delta ADC process. However, this argument is not persuasive. Applicant did not claim the arrangement "where only the front-end of the converter is placed in the implantable device, and the generated 1-bit data sequence is wirelessly transmitted to an external processing unit where the data is filtered for complete implementation of the sigma-delta ADC process". Claim 1 does not state splitting the "sigma-delta analog-to-digital converter" into a front-end and a back-end. Furthermore, Penn teaches the elements of claim 1 including an external processor ("external electronics") 24 that filters and processes a received data signal representative of the analog bioelectric signal, but does not teach a sigma-delta analog-to-digital converter (see prior Office Action, p. 4, mailed 28 May 2008). Zierhofer and Najafi teach such a device and Najafi provides the motivation to have that device in an implantable system, such as Penn's system (see col. 17, ll. 11-27). Penn's teaching already including transmission of a data signal representative of the analog bioelectric signal and receiving that signal in an external processor, which would then filter and process the signal.

As for Applicant's argument that "Zierhofer teaches that the data sequence generated by the sigma-delta modulator be stored to a memory in the implant before transferring the data to the outside via load modulation" and that "[i]n the present disclosure, the 1-bit data stream is transmitted directly to the external processing unit without being stored in the implanted device", the modification to Penn's system was to include Zierhofer's sigma-delta modulator to the signal conditioning circuit of Penn, and not to include Zierhofer's memory for storing the 1-bit data signal. Penn already teaches transmission of a data signal from the implanted device to an external processor. Besides, Applicant's claim includes the phrase "comprising" and not "consisting of". Thus, Applicant's interpretation of the claim, as to the negation of data storing means, is incorrect.